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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/024,622  | 12/21/2001  | Daniela Giacchetti   | 05725.0975-00       | 3918             |
| 22852   | 7590        | 03/24/2006           | EXAMINER            |                  |
| FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER<br>LLP<br>901 NEW YORK AVENUE, NW<br>WASHINGTON, DC 20001-4413 |             |                      | BORISSOV, IGOR N    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3639                |                  |

DATE MAILED: 03/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/024,622 | <b>Applicant(s)</b><br>GIACCHETTI ET AL. |  |
|                              | <b>Examiner</b><br>Igor Borissov     | <b>Art Unit</b><br>3639                  |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 and 27-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 and 27-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

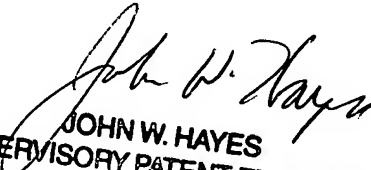
In view of the Appeal Brief filed on 10/03/2005 PROSECUTION IS HEREBY REOPENED, as set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

  
JOHN W. HAYES  
SUPERVISORY PATENT EXAMINER

### ***Response to Amendment***

Amendment received on 9/03/2004 is acknowledged and entered. Claims 32, 39 and 49 have been amended. New claims 53-61 have been added. Claims 1-61 are currently pending in the application.

### ***Claim Objections***

Claim Objections have been withdrawn due to the applicant amendment.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 31 and 49 are rejected under 35 U.S.C. 112, first paragraph**, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, Claims 31 and 49 recite the method step of: "*prescribing* a cosmetic product to the subject", which is not described in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 1-25 and 27-61 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent Claims 1, 5, 31, 39, 44, 45, 46, 48 and 50 recite a method for "*beauty care*", "*beauty tracking*", "*beauty advisory*" or "*beauty analysis*". It is not clear what does the term "beauty" actually contemplates. Merriam-Webster's collegiate dictionary (10<sup>th</sup> ed.; page 101) provides following definitions (among others) of the term "beauty" 1): the quality or aggregate of qualities in a person or thing that gives pleasure to the senses or pleasurably exalts the mind or spirit; 2): a beautiful person or thing; 3): a particularly graceful, ornamental, or excellent quality; 4): a brilliant, extreme, or egregious example or instance. The body of each independent Claim does not provide any indication of which definition of the term "beauty" should be considered during prosecution of the Claims. What type of said qualities should be considered: ornamental or graceful? If said "beauty" relates to the way a person looks, than what criteria is used

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for defining said “beauty” state: condition of hair, amount of wrinkles on the face, dimensions or color of eyes? Reading the preamble, the examiner does not understand what actually supposed to be diagnosed. Furthermore, said definitions clearly indicate that the term “beauty” is not a technical term, but rather is subjective one. As such, the term “beauty” renders the Claim vague and indefinite.

Furthermore, independent Claims 1, 5, 31, 32, 39, 44, 45, 46, 48, 49 and 50 employ one or more of the following terms: “facilitating”, “enabling”, “encouraging”, “prescribing”, “associating”, “instructing” and “causing”, which are vague and indefinite. For example, Claim 1 recites: “facilitating storage of information”. The Claim does not recite actual “storing” step. Therefore, the examiner does not understand how said “facilitating storage of information” step differs from “storing” step.

Furthermore, as per independent Claims 1, 5, 32, 39, 44, 45, 48 and 49, the preamble does not correspond to the body of the Claims. For example, The preamble refers to a “beauty care method”, while the body of the Claims recite only steps of recording data and presenting said data for viewing, without providing any indication of how said “beauty care method” is implemented. Same reasoning applied to the remaining Claims.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-25 and 27-61 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

In determining whether the claimed subject matter is statutory under 35 U.S.C. 101, a practical application test should be conducted to determine whether a “useful,

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concrete and tangible result” is accomplished. See *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998).

An invention, which is eligible or patenting under 35 U.S.C. 101, is in the “useful arts” when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a “useful, concrete and tangible result”. The test for practical application as applied by the examiner involves the determination of the following factors”

**(a) “Useful”** – The Supreme Court in *Diamond v. Diehr* requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished.

Applying utility case law the examiner will note that:

- i. the utility need not be expressly recited in the claims, rather it may be inferred.
- ii. if the utility is not asserted in the written description, then it must be well established.

**(b) “Tangible”** – Applying *In re Warmerdam*, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In *Warmerdam* the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

**(c) “Concrete”** – Another consideration is whether the invention produces a “concrete” result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

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The method steps recited in the Claims are expressed in the following terms:

“facilitating”, “enabling”, “encouraging”, “prescribing”, “associating”, “instructing” and “causing”, which are vague and indefinite. For example, in Claim 1, the step of “facilitating storage of information” does not recite an actual “storing” step, therefore, does not provide *useful* result. The method step or “enabling the subject to view the first information” does not recite an actual “displaying” step, therefore does not provide *tangible* result. In Claim 31, the step of “prescribing a cosmetic product” and “providing the subject with viewing access to the subject record” does not indicate real world application, therefore does not provide *tangible* result. In Claim 32, the method steps of “instructing the beauty facility to capture images” and “instructing the beauty facility to display ...images” does not recite an actual “capturing” or “displaying” steps, therefore, does not provide neither *useful*, no *tangible* result. Same reasoning applied to the remaining Claims.

Accordingly, the claimed invention does not appear to provide tangible and/or useful result and is, therefore, deemed to be non-statutory.

### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 31-38, 49, 57, 60 and 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Hawkins et al. (US 2002/0054714).**

Hawkins teaches a method and system for evaluating cosmetic product on a consumer, comprising:

**Independent Claim**

**Claim 31.** Selecting (prescribing) a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the user [0044].

**Claim 32.** Selecting a cosmetic product and capturing an image of a body feature before and after application of the cosmetic product at a sales counter (*beauty facility*) [0039]; [0053]; and displaying captured and transformed images to the user [0044]. Selecting the cosmetic product at the sales counter (*beauty facility*) inherently indicates *distributing* said cosmetic product to the point of sale. Examiner points out that without distributing said cosmetic product to said sales counter prior to offering said cosmetic product to the subject, it would not be possible to select and apply said product to the subject at said sales counter. Therefore, the step of "*distributing* said cosmetic product to the point of sale" is inherently disclosed in Hawkins. Furthermore, Hawkins teaches that the subject is assisted with said method at said sales counter by an operator [0053]. Examiner stipulates that without instructing said operator how to conduct said method prior to said "assisting" the subject, said operator would not be able to conduct said method. Therefore, the "instructing" steps are disclosed in Hawkins.

**Claim 49.** Selecting a cosmetic product for trial on the consumer's body (providing information) [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering (prescribing) a cosmetic product based on the results [0053]. Furthermore, Hawkins teaches that said method is a computer-implemented method [0053], thereby



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inherently indicating providing a computer-readable medium having instruction to conduct said method steps.

*Dependent Claims*

**Claim 33.** Capturing images at the beauty facility [0053] inherently indicates providing “know-how” for said capturing to the beauty facility. Same reasoning as applied to **Claim 32**.

**Claims 34-36.** Providing a kit for displaying a consumer’s skin images, including a camera and a programmable device [0026], inherently indicates providing necessary software (drivers) for the system to operate.

**Claim 37.** Same reasoning as applied to **claim 34**.

**Claim 38.** A cosmetic product is selected for a trial for a consumer before each image is recorded [0013]; [0014].

**Claim 54.** Displaying to the subject side by side an original image and a digitally transformed image of the subject’s face to demonstrate effects (effectiveness) of a cosmetic product treatment [0044].

**Claim 57.** Same reasoning applied to claim 49.

**Claim 60.** Same reasoning applied to claim 49.

**Claim 61.** See reasoning applied to claim 56.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-24, 27-30, 48 and 50-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins et al. (US 2002/0054714) in view of Marapane et al. (WO 01/87245).**

Hawkins teaches a method and system for evaluating cosmetic product on a consumer, comprising:

*Independent Claims*

**Claim 1.** Capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time after a cosmetic product has been applied by the consumer [0041]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing* of the transformed information) [0044]; displaying captured and transformed images to the user [0044].

Hawkins does not specifically teach storing information reflecting the subject's usage of the beauty product.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Claims 5 and 48.** Providing information about beauty products (selecting a cosmetic product for trial on the consumer's body) [0038]; capturing an image of a body feature [0039]; encouraging the subject to use at least one beauty product [0053]; capturing a further image of the body feature at a later time after a cosmetic product has

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been applied by the consumer [0041], wherein said capturing occurs at a sales counter (*beauty facility*) [0053]; digitally transforming the captured images to demonstrate effects of use of the cosmetic product (using a computer inherently indicates *storing of the transformed information*) [0044]; displaying captured and transformed images to the subject [0044].

Hawkins does not specifically teach storing information reflecting the subject's usage of the beauty product, the usage occurring on at least one occasion between capture of the first image and capture of the second image.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including taking initial color reading of the subject's hair; applying a beauty product to the subject's hair (coloring step); taking a second color reading of the subject's hair after said coloring step (page 8, lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include storing information reflecting the subject's usage of the beauty product, wherein the usage occurring on at least one occasion between capture of the first image and capture of the second image as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Claim 50.** Selecting a cosmetic product for trial on the consumer's body [0038]; capturing an image of a body feature [0039]; capturing a further image of the body feature at a later time [0041]; digitally transforming the captured images to determine differences that occurred in a body condition [0044]; offering a cosmetic product based on the results [0053]; wherein the method steps can be conducted at the subject's home over the Internet [0053], thereby indicating:

providing a computer-readable medium having instruction embedded therein for conducting said method; and

enabling subject to control the saved data.

Hawkins does not specifically teach providing instructions for storing information reflecting subject's behavior between capture of the first image and capture of the second image.

Marapane et al. (Marapane) teaches a method and system for recommending beauty products (hair color agents), said method including taking initial color reading of the subject's hair; applying a beauty product to the subject's hair (behavior step); taking a second color reading of the subject's hair after said coloring step (page 8, lines 8-10).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include providing instructions for storing information reflecting subject's behavior between capture of the first image and capture of the second image, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

*Dependent Claims.*

**Claims 2-3.** Same reasoning as applied to **claim 1**.

**Claim 4.** Said method and system, wherein obtaining information is occurs over the Internet [0053].

**Claims 6-9.** Said method and system, wherein a cosmetic product is offered at the point-of-sale [0053].

**Claim 10.** Said method and system, wherein enabling electronic capturing of at least one of the first and second first images includes providing the beauty facility with an image capture device [0053].

**Claim 11.** Said method and system, wherein access to the image capture device is provided over the Internet [0053].

**Claim 12.** Said method and system, wherein the external body condition is a skin condition of the subject's face [0046].

**Claims 13-14.** Same reasoning as applied to **claim 32**.

**Claim 15.** Same reasoning as applied to **claim 5**.

**Claim 16.** Same reasoning as applied to **claim 5**.

**Claim 17.** Same reasoning as applied to **claim 5**.

**Claim 18.** Displaying original and transformed images side-by-side to the consumer so that the consumer forced to pick one image [0044].

**Claims 19-20.** Providing a kit for displaying a consumer's skin images, said kit including a camera and a programmable device [0026], thereby inherently indicating providing necessary software (*drivers*) for the system to operate.

**Claims 21-22.** Same reasoning as applied to **claim 5**.

**Claim 23.** Said method and system, wherein said cosmetic product is offered to the consumer at a retail terminal [0053]. Information as to *is the retailer a manufacturer, reseller or wholesaler* is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. *See: In re Gulack 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) In re Dembiczak 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999).* The recited method steps would be performed the same regardless whether the distributor is a manufacturer, reseller or wholesaler.

**Claim 24.** Displaying a consumer's skin images on a computer monitor [0026] indicates use of a *tangible recording media*.

**Claim 27.** Communications via the Internet indicates viewing said images at locations remote from the beauty facility [0053].

**Claim 28.** Hawkins teaches that capturing of the consumer's first and second images may be provided either in the beauty facility, or user's home (*location remote from the beauty facility*), and that the communication between the beauty facility and the consumer may be conducted over the Internet [0053].

Hawkins and Marapane does not specifically teach that after the *first* image is taken in the beauty facility, the consumer *is recommended* to capture the *second* image at the *location remote from the beauty facility*.

However, Hawkins does teach that said method can be conducted from consumer' home using a digital camera and the Internet [0053].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins to include *recommending* the consumer to take the second image at home, because it would be convenient for the consumer to take the second image at the time suitable for the consumer.

**Claim 29.** Same reasoning as applied to **claim 5**.

**Claim 30.** Same reasoning as applied to **claim 27**.

**Claim 51.** Hawkins teaches that the consumer is enabled to maintain control through the use of software that stores the record at a location with access controlled by the consumer (conducting said method using consumer's digital camera at home and over the Internet) [0053].

**Claim 52.** Hawkins teaches said method and system, wherein the location is a portable information storage medium (the use of a computer at consumer's home indicates the use of the portable information storage medium) [0053].

**Claim 53.** Hawkins teaches displaying to the subject a digitally transformed image of the subject's face to demonstrate effects (effectiveness) of a cosmetic product treatment [0044].

**Claims 54-56.** Same reasoning as applied to Claim 5.

**Claims 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney et al. (WO 01/18674 A2) in view of Marapane et al. (WO 01/87245).**

*Independent Claims*

**Claim 45.** Maloney et al. (hereinafter Maloney) teaches a method and system for providing a customized product combination to a consumer, comprising: providing by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle (page 7, lines 1-2); obtaining feedback from the consumer (*update*) for the cosmetic products offered (page 12, lines 15-16); based on the collected and updated information recommending a cosmetic product to the consumer (page 12, lines 15-16).

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Maloney does not explicitly teach that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage.

Marapane teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

**Claim 46.**

Maloney teaches said method and system for providing a customized *cosmetic* product combination to a consumer, comprising: providing (recording) by the subject information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement and lifestyle over the Internet (page 7, lines 1-2); comparing the recorded information with a database of the same type of information of a plurality of individuals (page 7, lines 1-2, 9-11); determining whether the information provided by the subject is consistent with the same type of information of a plurality of individuals (page 7, lines 3-11; page 9, lines 21-22); recommending a cosmetic product to the subject based on said determination (page 7, lines 13-14).

Maloney does not explicitly teach that said provided by the consumer information regarding preferred colors and styles, desired look of hair, desired look of face, level of involvement includes customer cosmetic product usage.

Marapane teaches a method and system for recommending beauty products (hair color agents), said method including obtaining information regarding how often a

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subject has colored his/her hair over the past year (Figs. 1 and 16, item 130; page 4, lines 16-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include storing information reflecting the subject's usage of the beauty product, as disclosed in Marapane, and, accordingly, displaying captured information to the subject, because it would advantageously allow to estimate subject's body (hair or skin) condition and ability to receive another coloring, thereby provide the subject with most suitable product (Marapane; page 4, lines 17-18).

Dependent Claim.

**Claim 47.** Enabling the subject to record personal information about the subject's physical characteristics, and wherein the caused at least one product recommendation is a function of the subject's lifestyle and physical information (Maloney; lines 1-2).

**Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hawkins in view of Marapane et al. and further in view of AS/400 Redbook Softcopy Library, an image of a CD (Document).**

Dependent Claim

**Claim 25.** Hawkins teaches: displaying a consumer's skin images on a computer monitor [0026], thereby inherently indicating use of a *tangible recording media*.

However, Hawkins and Marapane does not teach that said tangible recording media includes a *visible marking* identifying a distributor.

Document discloses an image of a CD (which appears to be released in June, 1995), containing a *visual depiction* of a manufacturer/distributor (IBM).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hawkins and Marapane to include that said tangible recording media includes a *visible marking* identifying a distributor, because it would advantageously promote distributor's products.



**Claims 39-44 and 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maloney.**

*Independent Claims*

**Claim 39.** Maloney teaches: providing a subject with a image capturing device for recording and displaying personal beauty information including an image of a subject (page 20, lines 27-28; page 26, claim 20); wherein said recording and displaying indicates recording said information on a computer-readable media. Furthermore, Maloney teaches that said recorded information could be read at beauty facilities (a central location or kiosks) and updated (page 11, line 17-18; page 15, lines 4-6). Providing the subject with image capturing device at home indicates updating said personal beauty information at a location remote from the beauty facility.

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

**Claim 44.** Maloney teaches: recording, at beauty facilities (a central location or kiosks), personal beauty information of a subject, including an image of the subject (page 11, line 17-18; page 26, claim 20); wherein said recording and displaying obviously indicates recording said information on a computer-readable media. Furthermore, Maloney teaches that said recorded information can be accessed by the subject from home (remotely from the beauty facilities) (page 11, lines 13-14; page 6,

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lines 30-33); wherein providing the subject with image capturing device at home obviously indicates updating said personal beauty information at a location remote from the beauty facility. Furthermore, Maloney teaches allowing the subject to compare original and updated personal beauty information (page 20, lines 27-34).

Maloney does not explicitly teach that said computer-readable media is a transportable computer-readable media.

However, it is old and well known that computer-readable media can be a transportable. For example, Maloney teaches floppy diskettes, compact discs and laser discs as a computer-readable medium (page 13, lines 31-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Maloney to include that said personal beauty information is recorded on a *transportable* media, because it would advantageously allow to use this method in geographical locations where network communication is not available.

#### Dependent Claims

**Claim 40.** Providing the subject with image capturing device at home indicates updating step at a remote location (See reasoning applied to **claim 39**).

**Claims 41-43.** See reasoning applied to **claim 39**.

**Claim 58.** Maloney teaches: providing by the consumer personal beauty information (page 7, lines 1-2); wherein said information is provided on a transportable medium (a floppy diskette or compact disc, a handwritten questionnaire (page 13, line 31; page 6, line 32) or a digital camera (page 26, claim 20).

**Claim 59.** Maloney teaches: enabling a beauty facility (a central location or a kiosk) to record on transportable medium personal beauty information relating to beauty habits (page 6, line 32; page 7, lines 1-2; page 11, line 17; page 15, line 5; page 17, line 33).

#### ***Response to Arguments***

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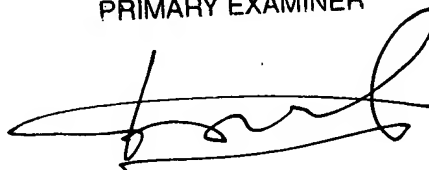
Applicant's arguments with respect to Claims 1-25 and 27-61 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IGOR N. BORISSOV  
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', written over a horizontal line.

IB

03/19/2006